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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/548,728	04/13/2000	Michael A. Epstein	PHA 23,671	7174

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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BRIARCLIFF MANOR, NY 10510

EXAMINER

REVAK, CHRISTOPHER A

ART UNIT PAPER NUMBER

2131

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/548,728	Applicant(s) EPSTEIN, MICHAEL A.	
	Examiner Christopher A. Revak	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-10 is/are allowed.
- 6) ☐ Claim(s) 1,2,4,5 and 11-13 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)          |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. <u>April 13, 2005</u> .                              |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>see attached</u> .  | 6) <input type="checkbox"/> Other: _____.                                   |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed December 28, 2004, with respect to claims 6-10 have been fully considered and are persuasive. Please refer to reasons for allowance section as to why the claims are allowable over the prior art.

Based upon the applicant's arguments, the examiner has similar found dependent claim 3 and the rejection has been withdrawn and the claims currently is objected to.

2. Applicant's arguments pertaining to claims 1-5 and 11-14 filed December 28, 2004 have been fully considered but they are not persuasive.

As per claim 1:

In response to applicant's arguments, the recitation "for limiting simultaneous copies of content material" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., number of copies of the software) are not recited in the rejected claim. Dependent claim 3 includes this limitation, but it is argued by the applicant pertaining to independent claim 1 of "the number of copies of the software" which it is not currently recited of that limitation. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

It is further argued by the applicant that "Ananda does not teach receiving a security response when a copy of the software is removed from the receiving device." The examiner respectfully disagrees. The examiner has reviewed the contents of the applicant's specification and the only recitation of "removal" of a copy of the software from a receiving device is found in separate embodiments in the applicant's specification. On page 4, lines 6-11 discloses of the receiving device performing a "return of the material corresponds to termination of access to the copy of the content material by the receiving device". In another embodiment, it is disclosed on beginning on page 5, line 28 of the "return/check-in" of the content material and continuing through page 6, line 5 of "a security device in the receiving device erases the selected content material from its memory or otherwise terminates access to this content material." In both instances, "termination of access to the content material" is conducted by the receiving device. Ananda discloses of terminating execution of the application software and notifies a user of the unauthorized use, see column 10, lines 8-10. The user is located at a remote computer, or which is interpreted as a receiving device as is claimed by the applicant, see column 2, lines 52-56. The user continues usage of the

application software as long as they are connected to the central rental facility, see column 2, lines 56-58. As discussed above, the teachings of Ananda do disclose of a receiving a security response, or a notification to a user, receiving device from the receiving device when the copy of the content material is removed (or access is terminated) from the receiving device.

For additional arguments sake, by terminating access to the content material in light of the teachings, it is essential that the content material is removed or erased from the remote computer, or receiving device, as is claimed by the applicant. The examiner understands that the teachings of Ananda do not disclose the application software permanently since it is disclosed in the teachings prevent a user from copying the application software to a storage device on the remote computer as is recited in the abstract. However, the examiner is interpreting that the content material is temporarily stored since it is essential for a processor to read contents from memory in order to execute the instructions on the user's computer. Evidence cited by the examiner includes the Microsoft's computer dictionary that discloses of the central processing unit is referred to as both the processor and the computer's memory, see page 82. In the book, How Computers Work, it is disclosed of a circular buffer that stores information that is used by the processor for execution and once the end of the buffer is reached, it returns to the beginning to see if more instructions are contained with it, see page 127, item #9. This circular buffer is interpreted as being temporary storage since it will be overwritten or erased with new data. One of ordinary skill understands that the processor has temporary storage so that instructions can be read by the processor and

the teachings of Ananda disclose of processing means, see column 6, lines 54-55, but fail to elaborate on the concept of temporary storage associated with the processor since one of ordinary skill understands this feature. It is noted that both teachings are not used as prior art, but to show that a CPU has a memory for temporarily storing instructions to be executed with an associated program.

As per claim 11:

It is argued by the applicant that Ananda fails to disclose "removing content material from a receiving device, and thus can not teach a security device that is configured to erase the content material from memory." The examiner respectfully disagrees. It is recited in the applicant's specification on page 4, lines 6-11 of the receiving device performing a "return of the material corresponds to termination of access to the copy of the content material by the receiving device". In another embodiment, it is disclosed on beginning on page 5, line 28 of the "return/check-in" of the content material and continuing through page 6, line 5 of "a security device in the receiving device erases the selected content material from its memory or otherwise terminates access to this content material." In both instances, "termination of access to the content material" is conducted by the receiving device. Ananda discloses of terminating execution of the application software and notifies a user of the unauthorized use, see column 10, lines 8-10. The user is located at a remote computer, or which is interpreted as a receiving device as is claimed by the applicant, see column 2, lines 52-56. The user continues usage of the application software as long as they are connected

to the central rental facility, see column 2, lines 56-58. As discussed above, the teachings of Ananda do disclose of a receiving a security response, or a notification to a user, receiving device from the receiving device and the copy of the content material is erased (or access is terminated) from the receiving device.

For additional arguments sake, by terminating access to the content material in light of the teachings, it is essential that the content material is removed or erased from the remote computer, or receiving device, as is claimed by the applicant. The examiner understands that the teachings of Ananda do not disclose the application software permanently since it is disclosed in the teachings prevent a user from copying the application software to a storage device on the remote computer as is recited in the abstract. However, the examiner is interpreting that the content material is temporarily stored since it is essential for a processor to read contents from memory in order to execute the instructions on the user's computer. Evidence cited by the examiner includes the Microsoft's computer dictionary that discloses of the central processing unit is referred to as both the processor and the computer's memory, see page 82. In the book, How Computers Work, it is disclosed of a circular buffer that stores information that is used by the processor for execution and once the end of the buffer is reached, it returns to the beginning to see if more instructions are contained with it, see page 127, item #9. This circular buffer is interpreted as being temporary storage since it will be overwritten or erased with new data. One of ordinary skill understands that the processor has temporary storage so that instructions can be read by the processor and the teachings of Ananda disclose of processing means, see column 6, lines 54-55, but

fail to elaborate on the concept of temporary storage associated with the processor since one of ordinary skill understands this feature. It is noted that both teachings are not used as prior art, but to show that a CPU has a memory for temporarily storing instructions to be executed with an associated program.

### ***Information Disclosure Statement***

3. The examiner has identified the applicant's information disclosure statement (IDS) submitted on April 13, 2000 and August 22, 2000 which have not been considered. The examiner has determined that the information disclosure statements are in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,2,4,5, and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ananda, U.S. Patent 5,638,513.

As per claim 1, it is disclosed by Ananda of a method comprising communicating a copy of content material to a receiving device. A security challenge is communicated to the receiving device when the copy of the content material is communicated to the



receiving device (col. 2, lines 47-58; col. 3, lines 12-14; col. 14, lines 29-32; col. 22, lines 50-54). A security response, based on the security challenge, from the receiving device when the copy of the content material is removed from the receiving device (col. 9, line 66 through col. 10, line 10).

As per claim 2, Ananda teaches of certifying of the receiving device before communicating the copy of the content material to the receiving device (col. 3, lines 12-14; col. 11, lines 2-25; and col. 12, lines 29-45).

As per claims 4 and 5, it is disclosed by Ananda of generating a random number, encrypting the random number (via a public key of a public-private key pair) that is associated with the receiving device to form the security challenge and the security response includes the random number. The receiving device is verified before communicating the copy of the content material to the receiving device wherein certification of the receiving device includes encryption (via a public key of a public-private key pair) of the receiving device (col. 11, lines 2-25 and col. 12, lines 29-45).

As per claim 11, the teachings of Ananda recite of a receiving device that receives content material and a corresponding security challenge from a check-out/check-in device. Memory is configured to store the content material and the corresponding security challenge. A security device is configured to erase the content material from the memory and communicate a security response to the check-out/check-in device based on the security challenge that is associated with the content material (col. 2, lines 47-58; col. 3, lines 12-14; col. 9, line 66 through col. 10, line 10;

col. 11, lines 2-25; and col. 12, lines 29-45; col. 14, lines 29-32; and col. 22, lines 50-54).

As per claim 12, Ananda teaches of a security device that is configured to communicate certification of the receiving device to the check-out/check-in device to enable the check-out/check-in device to provide content material to the receiving device (col. 11, lines 2-25 and col. 12, lines 29-45).

As per claims 13 and 14, it is disclosed by Ananda of a security device that includes a decrypter that decrypts the security challenge (via a private key of a public-private key pair that is associated with the receiving device) to form the security response. The security device is further configured to communicate a certification of the receiving device to the check-out/check-in device to enable the check-out/check-in device to provide the content material to the receiving device. The certification of the receiving device uses encryption (includes a public key of a public-private key pair) (col. 11, lines 2-25 and col. 12, lines 29-45).

### ***Allowable Subject Matter***

6. Claims 6-10 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter:

It was not found to be taught in the prior art of providing a limited number of simultaneous copies of content material to one or more receiving devices along with a security challenge, and receiving a security response from the receiving device when

the copy of the content material is removed from the receiving device and notifying a catalog controller whether the security response corresponds to an appropriate response to the security challenge.

8. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

It was not found to be taught in the prior art of maintaining a count of the simultaneous copies of the content material and decrementing the count when the security response is received from the receiving device when the receiving device removes the copy of the content material.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Fryer et al, "Microsoft Press Computer Dictionary" disclose of a central processing unit with memory.

White, "How Computers Work" disclose of circular buffers associated with a processor.

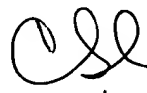
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 15, 2005  
  
CR

Christopher Revak  
AU 2131

  
4/15/05